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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LE, DAVID Q	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,528	SALAS ET AL.	
	Examiner	Art Unit	
	David Q Le	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7 and 9-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-7, 9-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. **Claims 1, 6-7, and 9** were amended as per the Amendment filed December 29th, 2003.

Claims 5, 8, and 15-50 were cancelled per the same Amendment.

Claims 1-4, 6-7, and 9-14 remain pending.

Double Patenting

2. **Claim 1** stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of ***Salas et al.***, prior U.S. Patent No. 6,314,408 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 is generic to claim 1 in *Salas*.

Claims 2-4, 6-7, and 9-14 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4, 5-6, and 7-12 of *Salas*, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-4, 6-7, and 9-14 are generic to claims 2-4, 5-6, and 7-12 of *Salas*, respectively.

The above double patenting rejections will remain until a terminal disclaimer is filed in compliance with 37 CFR 1.321(c). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-3, 6-7, and 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Smartsoft*** (Product Sales and Upgrade Sales, http://www.smartsoft.com) in view ***RealAudio/RealNetworks*** (RealAudio) (RealAudio Server – Ordering Information, http://www.realaudio.com).

As per **claim 1**.

Both Smartsoft and RealAudio disclose an ordering system for products through which a user can request a product (Smartsoft: Product or Product Selection; RealAudio: RealAudio Server-Ordering Information),

generate a license string (Smartsoft: License String; RealAudio: Ownership Information Settings: LicenseKey),

and transmit the License string to the user by email. (Smartsoft: Return License by: Email; RealAudio: Ownership Information Settings: "license ..received by email").

RealAudio further discloses that it uses a cryptographic process to generate the license string (RealAudio: Ownership Information Settings: Encrypted License String)

Smartsoft does not specifically disclose the license being generated by encoding at least one of (i) information associated with the product; and (ii) information associated with the request, by encoding at least one of a date of creation of the product; a version of the product; and a date of the request.

However, RealAudio does disclose that:

a) Their products may be licensed for limited time usage: servers good for 30-day evaluation, special "Events"(see website, above citations); these licenses are all based on "dates": date of start, date of expiration, i.e. date of the request from the customer, or date of creation of the product (encrypting, packaging, customizing features for it).

b) The licenses are also priced based on the number of intended users: RealAudio servers licensed for 60, 100, 500 concurrent "streams" (see website, above citations); the licenses are thus based on differing versions of the same product.

c) The licenses enable software on widely varying platforms: UNIX, MS Windows, Macintosh, others; provide varying modules: RealAudio/Video servers, with or without "RealFlash" (see website, above citations); each is a different "type" of license.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made that each license purchased would need to exactly identify the particular product it enables, the time period in which it would be enabled, as well as the time at which the request for the product was made, all this so that detailed accountability as well as thorough product support can be provided. Such a system would meet the following limitation of claim 1, generating the license string by encoding at least one of

a date of creation of the product;

a version of the product; and

a date of the request.

It would also have been obvious to ordinarily skilled in the art at the time of the invention that encryption of the license string, as taught by RealAudio, should always be used, in order to prevent fraudulent access and use of the products in question in case the transmissions were intercepted by unauthorized individuals.

As per **claims 2 and 12**.

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

Smartsoft and RealAudio further disclose an ordering and license delivery system on the Internet, i.e. a distributed communications network (see above citations/websites).

As per **claim 3**.

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

Smartsoft and RealAudio further disclose that payment information maybe received from the requestor (see above citations/websites).

As per **claim 4**.

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

Neither reference discloses verifying the received payment information. However it would have been common business practice to verify that payment was going to be successfully collected prior to transmitting a purchased license string, so that no time would be wasted in returning to customer for collection should said payment turn out to be un-collectable the first time around.

As per **claim 6**.

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

RealAudio further discloses that the cryptographic process generates the license string by encoding a character text string (RealAudio: Ownership Information Settings: "new or upgraded license, ...Example).

As per **claim 7** .

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

Both references further discloses a license string controlling access to the product when supplied by the requestor, see citations as per claim 1. Neither reference specifically discloses generating a license string as an upper case alphanumeric text string, the characters in the text string excluding capital O, capital I, and the numbers 0 and 1.

It is common in the computer arts to minimize as much as possible operator/user error when the operator/user needs to enter data into software applications. Occasionally key or license strings will be broken up into groups of 4-6 characters separated by hyphens for easier reading and transcribing. Similarly, the capital letters O and I are easily confused with the numbers 0 and 1 and may make it more difficult to read and correctly transcribe what typically is a long string of characters. This practice is common enough that there has apparently been no need to document it in the art.

However, the decision to exclude the capital letters O and I and the numerals 0 and 1 in a alphanumeric string serving as a license key is a design choice. The product provider may select any groups of alpha or numeric characters or hexadecimal or binary code or any combination thereof to compose each key license. Thus the claimed exclusion of these characters is an obvious design choice which a person of ordinary skill in the art would have found obvious and applicant has provided no evidence that would indicate his particular exclusion of these characters gives rise to any new or unexpected result. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

As per **claim 13:**

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

RealAudio also discloses that it provides a 30-day FREE sample of its RealAudio Server (RealAudio: Try RealAudio Server 3.0; Use It Free for 30 days). The product only functions for a pre-determined period of time if a license string is not entered into the product.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included this feature taught by RealAudio into any license providing system, so that a "try before you buy" appeal may create more customers for the system.

As per **claim 14**:

Both Smartsoft and RealAudio disclose all the limitations of claim 1.

RealAudio further discloses that its servers may be enabled or maintained by purchasing a "new or upgraded license" (Real Audio: Ownership Information Settings). The license string in this instance enables the product to function beyond the pre-determined period of time.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made that once a user has tried a product, has liked it, and decides to purchase it, then providing a license string that would make the trial product become fully operational would save the time and cost of downloading a new version of the product in question. This would result in happier customers and increased sales for the system operator.

5. **Claims 1-4, 6-7, 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Barber***, US Patent No. 5,390,297.

As per **claim 1**.

Barber discloses: receiving a request for a product, (Column 8, lines 20-65);

generating, substantially at the time the request is received, a license string that controls access to the product, see Column 8, line 65 - Column 9, line 1;

transmitting the license string to the requestor, see Column 9, lines 1-2.

Barber does not specifically disclose the license being generated by encoding at least one of (i) information associated with the product; and (ii) information associated with the request.

However it would have been obvious to one ordinarily skilled in the art at the time the invention was made that these would be inherent information that would be required in a license string, so that the string will serve as a unique key for a particular product and a particular user. Such uniqueness would ensure that no one but the authorized user may have access to the product in question, and would also allow the provider to accurately track, maintain, and update the licenses issues to each individual user and product.

As per **claim 2**.

Barber discloses all the limitations of claim 1. *Barber* further discloses a distributed network, see Figure 1.

As per **claim 3**.

Barber discloses all the limitations of claim 1. *Barber* further discloses the request includes a request and payment information, see Column 8, lines 20-65.

As per **claim 4**.

Barber discloses all the limitations of claim 1.

Barber further discloses verifying payment information, see Column 8, lines 20-65.

As per **claim 6**.

Barber discloses all the limitations of claim 1.

Barber further discloses the cryptographic process generates the license string by encoding a character text string, see Column 8, line 48 - Column 10, line 62.

As per **claim 7** .

Barber discloses all the limitations of claim 1.

Barber further discloses a license string controlling access to the product when supplied by the requestor, see Column 8, line 48 - Column 10, line 62. Barber does not specifically disclose generating a license string as an upper case alphanumeric text string, the characters in the text string excluding capital O, capital I, and the numbers 0 and 1.

It is common in the computer arts to minimize as much as possible operator/user error when the operator/user needs to enter data into software applications. Occasionally key or license strings will be broken up into groups of 4-6 characters separated by hyphens for easier reading and transcribing. Similarly, the capital letters O and I are easily confused with the numbers 0 and 1 and may make it more difficult to read and correctly transcribe what typically is a long string of characters. This practice is common enough that there has apparently been no need to document it in the art.

However, the decision to exclude the capital letters O and I and the numerals 0 and 1 in a alphanumeric string serving as a license key is a design choice. The product provider may select any groups of alpha or numeric characters or hexadecimal or binary code or any combination thereof to compose each key license. Thus the claimed exclusion of these characters is an obvious design choice which a person of ordinary skill in the art would have found obvious and applicant has provided no evidence that would indicate his particular exclusion of these characters gives rise to any new or unexpected result. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

As per **claim 10**.

Barber discloses all the limitations of claim 1. *Barber* further discloses the license string controls access to a single facility, see Column 8, lines 40-41.

As per **claim 11**.

Barber discloses all the limitations of claims 1. *Barber* further discloses the license string controls access to multiple facilities, see Column 8, lines 20-48.

As per **claim 12**.

Barber discloses all the limitations of claim 1. *Barber* discloses a License string which can be returned by over a network, see Column 9, lines 1-2.

6. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over ***Barber*** in view of ***He et al***, US Patent No. 6,088,451.

Barber discloses all the limitations of claim 1.

Barber does not specifically disclose generating a license string including validation information.

He et al teaches the use of a checksum, a well known method for data string validation, see Column 10, lines 18-47, for the benefit of protecting information from being accidentally or maliciously changed and ensuring correct communication between user and the network.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to include the checksum validation taught by He et al in the invention of Barber for the benefit of protecting information from being accidentally or maliciously changed and ensuring correct communication between user and the network.

7. **Claims 13, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Barber*** in view of ***Edwards Jr***, US Patent No. 5,014,234.

As per **claim 13**.

Barber discloses all the limitations of claim 1.

Barber does not specifically disclose the product functions for a predetermined period of time before the license string is entered.

Edwards Jr teaches limited usage for predetermined period of time before the license string is entered, see Column 1, line 25 - Column 2, line 3 for the benefit of providing a "try before you buy" license feature and still allow protection of the software.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Barber to allow usage for a predetermined period of time before the license string is entered providing a "try before you buy" license feature and still allow protection of the software.

As per **claim 14**.

Barber in view of Edwards Jr discloses all the limitations of claim 13.

Barber discloses that the license string enables use of the product, see Column 8, line 20 - Column 10, line 63.

Barber does not specifically disclose entry of the license string extends the predetermined time for which the product will function.

Edwards Jr teaches entry of the defuse number extends the usage for predetermined period of time, see Column 8, lines 16 - 39 for the benefit of allowing continued use of the product and still allow protection of the software.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of *Barber* to allow usage for a predetermined period of time after the license string is entered for the benefit of allowing continued use of the product and still allow protection of the software.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DQL

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